



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,711	04/27/2000	Benjamin Frydman	376462000400	4281

25226 7590 07/24/2003

MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO, CA 94304-1018

EXAMINER

DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
----------	--------------

1621

DATE MAILED: 07/24/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,711

Applicant(s)

FRYDMAN ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 16-32 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 16 is/are allowed.
- 6) ☒ Claim(s) 17-23 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Clarification

Updated status of claims (after withdraw of the preliminary amendment (Paper No. 13) and the entry of the amendment (Paper No. 14) filed in response to the first Office Action (Paper No. 12)): Claims 1-6 and 16 (Group I), Claims 17-23 and 32 (Group II) and Claims 24-31 (Group III) are pending. Groups II and III had been previously withdrawn from consideration

102 Rejections Withdrawn

The rejection of claims 1-16, in so far as they read on the single additional species defined in the previous Office Action (Paper No. 12), under 35 USC 102(b) is withdrawn. The reference was factually misinterpreted. The examiner regrets the error. Additionally, applicant's amendment cancels claims 7-15.

Allowable Subject Matter

The elected species and its obvious variant remain free of the prior art. In view of the withdraw of the outstanding 102 rejection, the search was therefore expanded as called for under current Office Markush practice. This resulted in all remaining species being searched. The pending compound claims 1-6 and 16 are allowable. That being the case, the claims of Group II (Claims 17-23) will be rejoined and are allowable over

Art Unit: 1621

the art. The claims of Group III will not be rejoined as they are unrelated to the allowable polyamine compounds of claims 1-6 and 16.

Claims 17-23 and 32 would be allowable once the following 112 rejections have been overcome:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear exactly how an "indication" is treated i.e. does the term "indication" refer to a specific underlying disease, the treatment of a symptom, or has some other applicant-defined meaning. Additionally, The term 'effective amount' (therapeutic amount) is indefinite where the claim fails to state the function which is to be rendered effective. *In re Frederic's*, 102 USPQ 35 (CCPA 1954). Finally, it is unclear if the "polyamine analog of claim 1" is in fact the set of compounds of claim 1, or some other derivatives or analogs thereof. The examiner respectfully suggests deleting the word "analog."

Claims 19 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As above, the exact meaning of the term "indication" is unclear.

Art Unit: 1621

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As above, the exact meaning of the term "indication" is unclear. Additionally, it is unclear exactly what "*problems* [emphasis added] associated with tissue grafts and organ transplants" applicant wishes to refer.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if the "polyamine analog of claim 1" is in fact the set of compounds of claim 1, or some other derivatives or analogs thereof. The examiner respectfully suggests deleting the word "analog."

The remaining dependent, claims 18, 20 and 23, are also rejected under 35 USC 112, second paragraph, as claims which depend from indefinite claims are also indefinite. *Ex parte Cordova*, 10 USPQ 2d 1949, 1952 (PTO Bd. App. 1989).

Conclusion

In view of the extensive changes made to the claims during the course of prosecution, the examiner respectfully requests that a clean copy of all pending claims be included in applicant's next communication.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 3,008,993 is cited to show related compounds.

Art Unit: 1621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 703-305-7129. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

 **BRIAN DAVIS**
PRIMARY EXAMINER

Brian J. Davis
July 18, 2003